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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,648	07/23/2002	Jean Kaufmann	FE-19PCT	9225

7590 01/14/2005
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317 Madison Avenue
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EXAMINER

NGUYEN, SON T

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,648

Applicant(s)

KAUFMANN ET AL.

Examiner

Son T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-11 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1,4-6,8,10** are rejected under 35 U.S.C. 102(b) as being anticipated by Simington (US 4005Simington).

For claim 1, Simington discloses a snaffle bit for horses comprising a mouthpiece consisting of at most two parts 18,20, which can be placed between the upper and lower jaws and extends crosswise through the mouth, the mouthpiece has a through opening (the openings are at each end where the rings go through) at each of its two ends projecting out from the sides of the mouth, each opening carrying a ring 14,16, wherein the mouthpiece has the shape of an outward-curved bow extending across the tongue and lower jaw and, wherein the bow shape of the mouthpiece is located on a plane extending substantially perpendicular to the through-openings.

For claim 4, Simington discloses the mouthpiece consists of two parts 18,20.

For claim 5, Simington discloses the mouthpiece comprises two side parts (see fig. 3) which are connected by a joint 24,26, wherein the joint can pivot around an axis approximately perpendicular to the plane.

For claim 6, Simington discloses the joint is located approximately in the center of the mouthpiece (see fig. 3).

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For claim 8, Simington discloses a cross section of the mouthpiece is approximately circular.

For claim 10, Simington discloses wherein pivot bearing sockets (the extension at the end of the mouthpiece) which project out from at least one side of the through-openings and which represent extensions of these openings, are provided on the free ends of the mouthpiece, perpendicular to or at an angle of $< 90^\circ$ to the plane formed by the bow shape.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Simington (as above) in view of Scherling (US 290Scherling).

Scherling teaches a snaffle bit for horses comprising a mouthpiece A, which can be placed between the upper and lower jaws and extends crosswise through the mouth, the mouthpiece has a through opening (the openings are at each end where the rings go through) at each of its two ends projecting out from the sides of the mouth, each opening carrying a ring (not numbered but shown in the figures), wherein the mouthpiece has the shape of an outward-curved bow extending across the tongue and lower jaw (see fig. 1 for the outward curved shape). In addition, the mouthpiece comprises two side parts (fig. 1 shows 3 parts, the examiner is considering the first and

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third (looking from left to right) being the left and the right parts) which are connected by a joint (fig. 1, a joint is created at a,c or the whole ref. A, which also includes a,c on each side), wherein the joint can pivot around an axis approximately perpendicular to the plane. Furthermore, as shown in fig. 4, which replaces a,c, Scherling discloses a pin g passes through ends of the side parts, the pin being held in place at an end of the side part containing ref. h, which forms a joint fork (as shown in fig. 4).

It would have been an obvious substitution of functional equivalent to substitute the joint connection 24,26 of Simington with a pin passes through the ends of the side parts which form the joint, the pin being held in place in the end of the one of the two side parts which forms the joint fork as taught by Scherling, since both types of joint connection would perform to connect the parts of the mouthpiece together and allow the parts to pivot.

5. **Claims 9 & 11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Simington (as above) in view of Conrad (US 4587Conrad).

Conrad teaches a bit comprising a mouthpiece 1 that is made out of steel, which is a non-oxidizing material (col. 3, lines 34-35). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the mouthpiece of Simington out of steel as taught by Conrad, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious choice. In re Leshin, 125 USPQ 416.

Response to Arguments

6. Applicant's arguments filed 10/25/04 have been fully considered but they are not persuasive.

Applicant argued that the Examiner has overlooked the third part, namely the center coupling member 22 that connects the two parts 18, 20 together. Without this center member 22 the two parts 18, 20 would not be connected together. Thus, Simington (564) does not disclose a snaffle bit having a mouthpiece consisting of at most two parts. The mouthpiece of Simington consists of three pieces, not two as in the presently claimed invention.

The Examiner does not believe that she overlooked the so called third part 22 because it is a connection member and not part of the mouthpiece. This connection member 22 of Simington is the same concept of connection member, i.e. pin 13, of Applicant's invention. If argued so, then Applicant's mouthpiece does not consist at most two parts because one has to account for the pin 13, connection member 12, fork 11 as described in Applicant's specification. Therefore, the Examiner believes that Simington anticipates in the claim language of "a mouthpiece consisting of at most two parts".

Applicant argued that Scherling (803) does not teach a bit having a mouthpiece made of at most two parts.

Scherling was not relied upon for a teaching of a mouthpiece made of at most two parts (see the rejection above). Scherling was relied solely for the fact that he employs pins g to allow pivoting movement of parts of the mouthpiece. The pins as

taught by Scherling are alternative method of connection in place of the connection member 22 of Simington, thus would be obvious substitution of functional equivalent type of connection means.

Applicant argued that the 797 patent is non-analogous with a mouthpiece for a horse because 797 teaches a method of making wrenches.

The Examiner has made a typographical error in typing in the patent number. The correct patent number is 4587797 to Conrad as used above in the rejection. Conrad is solely relied upon for a known material usage, i.e. steel for mouthpiece. Thus would be obvious to one having ordinary skill in the art at the time the invention was made to manufacture the mouthpiece of Simington out of steel as taught by Conrad, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious choice.

Even with this typographical error, the Examiner believes that Applicant could have realized that it was a typographical error because why would the Examiner cite a method of making wrenches for a teaching of a mouthpiece for a horse. In addition, on PTO-892, the mis-typed patent of Shaw (458797) is not cited thereon, and the correct patent of Conrad (4587797) is cited thereon; thus, the Applicant should realized that Conrad (797) is the one that the Examiner relied upon in the detailed action mailed on 7/26/04. Furthermore, in the detailed action, the Examiner points out certain columns and lines for the Conrad patent, which these columns and lines do not match the Shaw patent (458797); therefore, Applicant should have realized this and either check the

PTO-892 form or attempt to call the Examiner within one month of the mailing date of the detailed action mailed on 7/26/04. The Examiner apologized for the error and inconvenience to the Applicant.

Conclusion


7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son T. Nguyen whose telephone number is 703-305-0765. The examiner can normally be reached on Mon-Thu from 10:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on 703-308-2574. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Son T. Nguyen
Primary Examiner
Art Unit 3643

stn